

AMENDMENTS TO THE DRAWINGS

One (1) replacement sheet of Figure 5 is attached following page 32 of this paper.

Fig. 5 has been amended to correctly show that the first party 501 performs step C, in accordance with the disclosure in ¶¶ 102-103 of the present application. The Applicant submits that no new matter has been added by the Replacement Sheet of Figure 5.

REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. By this Amendment, claims 1-22, 25, 27, and 29-31 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0135860, issued to Dureau (hereinafter, Dureau). Claims 6, 9, 16, 19, 26, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dureau, in view of U.S. Patent Application Publication No. 2003/0066084, issued to Kaars (hereinafter, Kaars). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. Information Disclosure Statement

The Examiner states the following in page 2 of the Office Action:

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Incorporated references

(Attorney Docket No. 14185US02 and Attorney Docket No. 14274US02)
are disclosed in paragraph [02] of the specification.

The Applicant points out that it is believed that none of the references cited in the cross-reference section (or any other section that incorporates an application by reference) of the present application qualify as prior art to the present application. In instances where a cross-reference section was used (or any other section which incorporates an application by reference), the Applicant points out that the Examiner was simply being notified of applications that may be considered related to the present application (e.g., including at least one common inventor and/or a common disclosure with the present application). Therefore, it is believed that none of the references cited in the cross-reference section (or in any other section that incorporates by reference) need to be cited in an IDS.

II. Specification

The specification was objected to because of various informalities. The Applicant has amended the specification as set forth above to overcome these objections.

The specification was also objected to as failing to provide proper antecedent basis for the claimed subject matter. The Office Action further states:

Correction of the following is required: The specification does not distinctly define the characteristics of each of the claimed processors of Claim 31: a media processing system processor, a media management system processor, a computer processor, a media exchange software

processor and a media peripheral processor (paragraph [16]). Without further disclosure as to the distinctness of each claimed processor in Claim 31, each claimed processor will be treated as indistinguishable and therefore the broadest reasonable interpretation of a processor will be used in the interpretation of Claim 31.

See Office Action at pages 3-4. The Applicant respectfully disagrees and points out that the various types of processors stated in claim 31 are stated in paragraphs 16 and 83 of the specification. In addition, the Applicant submits that it is known in the art what the terms "media peripheral", "computer", and a "storage system" mean. Therefore, the Applicant submits that there is no need for further clarification of the terms "media peripheral processor", "computer processor", and a "storage system processor." With regard to the terms "media processing system (MPS)" and "media exchange software (MES)", the Applicant submits that the specification is sufficiently informative as to the meaning of these terms. For example, the Examiner is referred to Figures 1A-3 and the corresponding description in paragraphs 36-98 for additional information on what is meant by "media processing system (MPS)" and "media exchange software (MES)". Obviously, a "media processing system (MPS) processor" and a "media exchange software (MES) processor" would be a processor that performs one or more of the functionalities of a "media processing system (MPS)" and a "media exchange software (MES)", as already described in the specification.

The Applicant respectfully requests that the objections to the Specification be withdrawn.

III. Drawings

The drawings were objected to because of incorrect labeling. Fig. 5 has been amended to correctly show that the first party 501 performs step C, in accordance with the disclosure in ¶¶ 102-103 of the present application. The Applicant submits that no new matter has been added by the Replacement Sheet of Figure 5.

REJECTION UNDER 35 U.S.C. § 102

IV. Dureau Does Not Anticipate Claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31

The Applicant now turns to the rejection of claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 under 35 U.S.C. 102(e) as being anticipated by Dureau. With regard to the anticipation rejections under 102, MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

Without conceding that Dureau qualifies as prior art under 35 U.S.C. 102(e), the Applicant respectfully traverses this rejection as follows.

A. Rejection of Independent Claims 1, 11, and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. § 102(e), the Applicant submits that Dureau does not disclose or suggest at least the limitation of "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location," as recited by the Applicant in independent claim 1.

The Office Action states the following:

The claimed "converting within said first home, said received media file from said first format to a second format compatible for at least one of presentation and playback on a television screen within said first home" is met by Dureau that discloses the converting of received data by a proxy receiver, 12, from a first format to a second format and the use of any number of receiving devices, 30A-N, including a television for the display of the transcoded data (Abstract; Figs.1,2&4; paragraphs [0012], [0028], & [0035-0037])

See the Office Action at pages 5-6. Referring to FIG. 1 of Dureau, the proxy receiver 12 initiates transcoding of received data to a target data format for one or more of the receivers 30A-30D. See Dureau at Abstract and ¶ 0028. However, the Applicant points out that the receiver 12 and the receivers 30A-30D of Dureau are in the same geographic location. In this regard, the proxy receiver 12 converts the received media in a format that is compatible only with devices located at the same geographic location as the proxy receiver 12.

Therefore, Dureau does not disclose or suggest at least the limitation of "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Dureau and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 1, 11, and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-5, 7, 8, 10, 12-15, 17, 18, 20, 22-25, 27, 28, 30, and 31

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Dureau has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-5, 7, 8, 10, 12-15, 17, 18, 20, 22-25, 27, 28, 30, and 31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-5, 7, 8, 10, 12-15, 17, 18, 20, 22-25, 27, 28, 30, and 31.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161

(Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

V. The Proposed Combination of Dureau and Kaars Does Not Render Claims 6, 9, 16, 19, 26, and 29 Unpatentable

The Applicant now turns to the rejection of claims 6, 9, 16, 19, 26, and 29 as being unpatentable over Dureau in view of Kaars.

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Dureau has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Kaars) does not overcome the deficiencies of Dureau, claims 6, 9, 16, 19, 26, and 29 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6, 9, 16, 19, 26, and 29.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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